

REMARKS

Reconsideration of this application is respectfully requested.

In the Final Official Action, the Examiner has withdrawn the indication of finality with regard to the previous Office Action and has also withdrawn the indication of allowability as to claims 7-9.

In the Official Action, the Examiner rejects claim 9 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner argues that the term “the edge surface” has no antecedent basis in the claim. In response, claim 9 has been amended to change “the edge surface” to --an edge surface--. Accordingly, it is respectfully requested that the rejection of claim 9 under 35 U.S.C. § 112, second paragraph, be withdrawn.

The Examiner now rejects claims 5-7, 9 and 10 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,352,503 to Matsui et al., (hereinafter “Matsui”) in view of U.S. Patent Application Publication No. 2003/0163029 to Sonnenschein et al., (hereinafter “Sonnenschein”).

In response, Applicants respectfully traverse the Examiner’s rejection under 35 U.S.C. § 103(a) for at least the reasons set forth below. However, independent claims 7 and 10 have been amended to clarify their distinguishing features. Claim 5 has been canceled thereby rendering the rejection thereof moot. Claim 6 has been amended to change its dependency from canceled claim 5 to claim 7. Claim 9 has been amended to be consistent with its amended base claim.

Specifically, claims 7 and 10 have been amended to recite:

“a screen size has a length in the horizontal direction longer than that in the vertical direction, the end of the first treatment-tool is guidable in the vertical direction on the side of the shorter side from the inside to outside of the field of view or from the outside to inside of the field of view, and the end of the second treatment-tool is guidable in the horizontal direction on the side of the longer side in the range of the field of view.”

The amendment to claims 7 and 10 is fully supported in the original disclosure, such as at original claim 5 and Figures 5 and 6 of the Drawings. Thus, no new matter has been introduced into the disclosure by way of the present amendment to independent claims 7 and 10.

Applicants respectfully reiterate and submit that Matsui does not teach or suggest that the distal end of one of the treatment tools is guided outside the field of view. In the Final Official Action, the Examiner cites Figure 29 and column 14, lines 10-67 as showing such a feature. Figure 29 does not show a field of view and Figure 27 (which does show the field of view) clearly shows one of the instruments being moved within the field of view (by arrow and broken lines). Column 14 also does not teach, suggest or even mention such a feature.

With regard to newly cited Sonnenschein, e.g., Figs. 3A-3C, which show circular observational fields of view having various sizes, do not teach or suggest the features illustrated in Figs. 5, 6, 8, 10-12, 14 of the present application and recited in claims 7 and 10.

However, in the interests of advancing prosecution and in order to clarify such features, independent claims 7 and 10 have been amended as discussed above.

The features now expressly recited in claims 7 and 10 provide an advantage not present or contemplated by the prior art, namely, allowing improved viewability of an object in the field of view, operability and workability of the treatment tools for the operator.

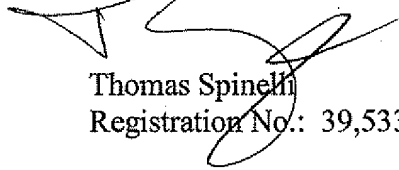
Further, the endoscope apparatus as recited in claims 7 and 19 not only varies the size of the field of view in up/down and left/right directions of the screen, but also the setting of the moving range of each of the treatment-tools, thereby providing an advantage of improving the viewability and operability of the treatment tools during work (e.g., during working with one treatment tool, the other treatment tool can be positioned on the outside of the field of view). In contrast, even the combination of Matsui and Sonnenschein, which lack the concept of coordination between the field of view range and the moving range of each of the treatment tools, do not disclose or suggest the features recited in claims 7 and 10, and cannot achieve the above-mentioned advantages thereof.

With regard to the rejection of claims 5-7, 9 and 10 under 35 U.S.C. § 103(a), Independent claims 7 and 10 are not rendered obvious by the cited references because neither the Matsui patent nor the Sonnenschein patent Application, whether taken alone or in combination, teach or suggest an endoscope apparatus having the features discussed above and recited in independent claims 7 and 10. Accordingly, claims 7 and 10 patentably distinguish over the prior art and are allowable. Claims 6 and 9, being dependent upon claim 7, are thus at least allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 5-7, 9 and 10 under 35 U.S.C. § 103(a).

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone

conference with Applicants' attorneys would be advantageous to the disposition of this case,
the Examiner is requested to telephone the undersigned.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Thomas Spinelli", is written over the typed name and registration number.

Thomas Spinelli
Registration No.: 39,533

Scully, Scott, Murphy & Presser, P.C.
400 Garden City Plaza, Suite 300
Garden City, New York 11530
(516) 742-4343
TS:cm